

REMARKS

Applicants thank the Examiner for the very thorough consideration given the present application.

Claims 1-20 are now present in this application. Claims 1, 15, 18 and 20 are independent. By this Amendment, claim 20 is added. No new matter is involved.

Reconsideration of this application is respectfully requested in light of the following remarks.

Rejections under 35 U.S.C. §103

Claims 1-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,999,827 to Sudo et al. ("Sudo") in view of U.S. Patent 5,822,221 to Groenteman, and further in view of U.S. Patent 7,093,201 to Duarte. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

Because the rejection is based on 35 U.S.C. §103, what is in issue in such a rejection is "the invention as a whole", not just a few features of the claimed invention. Under 35 U.S.C. §103, "[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The determination under section 103 is whether the claimed invention

as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. See In re O'Farrell, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). In determining obviousness, the Examiner must explain what the differences between the claimed invention and the prior art are and provide objective factual evidence to support a conclusion that it would be obvious to one of ordinary skill in the art to achieve the claimed invention, which includes those missing features.

In rejecting claims under 35 U.S.C. §103, it is incumbent on the examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested

by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A showing of a suggestion, teaching, or motivation to combine the prior art references is an “essential evidentiary component of an obviousness holding.” C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not “evidence.” See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

Claim 1 recites a combination of features that is neither disclosed nor suggested by the applied art, alone or in combination.

To start with, claim 1 recites a portable terminal for presenting information regarding a plurality of devices in a proximate environment. None of the applied references discloses or suggests such a device. Sudo, the base reference, is directed to a portable telephone communication terminal that uses either a scroll knob 4 in a first embodiment to scroll through various displayed information, selection of particular information being made by a separate key; or a jog dial 36J in a second embodiment, to scroll through various displayed items by rotating the jog dial, and to select

a displayed item by laterally moving the jog dial in its existing rotated position.

There is no concept whatsoever in Sudo of a number of positively claimed features, including (1) presenting information regarding a plurality of devices in a proximate environment.

While Sudo does present telephone information such as, for example telephone numbers, Sudo is totally devoid of any concept of presenting information regarding a plurality of devices in a proximate environment.

Also, there is no concept whatsoever in Sudo of a display for selectively displaying information data of a selected one of said devices.

Nor does Sudo disclose a means for selecting any one of said devices, in general, or as specifically claimed. For example, Sudo fails to display an array of display objects representing individual devices in a proximate environment, or a marker displayed on said display, said array and said marker being movable relative to one another.

Sudo does disclose a marker (e.g., cursor K) on its display that moves up or down. However, Sudo definitely does not disclose a movement of the movable operating element by an operator that results in a substantially coincident movement of said array or marker. In this regard, Applicants note that rotary movement of jog wheel 36j does not result in a coincident rotary movement of cursor K. Rather, rotary movement of jog wheel 36j results linear (up and down) movement of cursor K.

Nor does Sudo disclose that its movable operating element (e.g., jog wheel 36j) is positioned so that it appears to an operator to at least partially overlap with the display such that said array or said marker appears to an operator to be part of the operating element, as claimed.

Rather, there is no apparent overlap whatsoever of Sudo's scroll knob 4 or its jog wheel 36j with Sudo's display, in any way whatsoever, let alone so that the marker appears to an operator to be part of the operating element. To the contrary, the only part of scroll knob 4 or jog wheel 36j that appears visually to an operator is the part of the scroll knob or jog wheel that does not overlap in any way whatsoever with Sudo's display (12 or 35).

This analysis of Sudo, with respect to the features that are positively recited in claim 1, reveals numerous shortcomings of Sudo with respect to the claimed invention.

Instead of admitting these numerous clear differences between the claimed invention and Sudo, the Office Action glosses over these shortcomings and, instead, speculates that Figs. 2, 3 and 7, scroll knob 4, display 12, jog wheel 36j, and four separate columns of Sudo's disclosure meets all features of claim 1 except that "part of the software on the portable device is used to gather and display information about devices on a network (office equipment, i.e., printers, fax, etc.)." Applicants strenuously disagree with this highly conclusionary, broad brush approach that fails to present a one-to-one correspondence between each claimed feature and a corresponding feature in Sudo, and which completely overlooks the aforementioned detailed differences between claim 1 and Sudo.

In an attempt to remedy the deficiencies of Sudo with respect to the claimed invention, the Office Action then turns to Groenteman, which discloses an office machine monitoring device using a transceiver unit 36, with respect to which absolutely no structural features are presented. All that is presented is a highly schematic diagram of the functional components of such a transceiver, which is disclosed as a radiofrequency device. In fact, transceiver 36 is not

disclosed as a telephone whatsoever.

Despite these significant differences, the Office Action concludes that “[I]t would have been obvious to combine Groenteman into Sudo . . . because Groenteman describes a portable device with the same component makeup of Sudo without an auxiliary input mechanism (“jog dial”).” The Office Action continues by stating that “one of ordinary skill in the art would recognize the techniques of Groenteman can be ran (sic: run) on any portable devices with a controller (CPU) and memory for holing (sic: holding) software modules that which when ran (sic: run) execute the monitoring function of devices on a network.”

Applicant respectfully disagrees with these speculative conclusions, none of which is supported by objective factual evidence, and which run contrary to the disclosures of Sudo and Groenteman, for the following reasons.

Firstly, Groenteman’s transceiver unit 36 is a very simple device that, as disclosed, needs no user interface whatsoever, and is not manipulated by a user in any way whatsoever. It is disclosed as being “located internal to an office machine 30 or external to an office machine 30” – see col. 2, lines 21-29, for example. The Office Action completely fails to explain why a user would manipulate it in any way, or how a user would manipulate it in any way, especially if it is located internal to an office machine 30, where a user will not have access to it to operate it.

Secondly, the function of transceiver 36 is to merely receive alarm and status information from microcontroller unit 34 and to wireless transmit that information to a supervisory transceiver base unit 28 within office machine monitoring network 28 - see col. 2, lines 52-61. This is a very simple function and has no need to be implemented in a user operated cell phone,

like that of Sudo. In fact, Sudo's cell phone's numerous telephone functions would be completely wasted on Groenteman's disclosed transceiver function.

Applicants respectfully submit that one of ordinary skill in the art would have absolutely no incentive to use Sudo's user manipulated cell phone to perform the simple transceiver function of Groenteman's transceiver 36, that operates without the need for any user input, and with respect to which Sudo's almost all of cell phone's functions would be useless, and to implement Sudo's portable phone's transceiver functions, would require a human user to answer a call from Groenteman's microcontroller that does not have the capability of dialing a cell phone, and call a transceiver base station that has no capability of receiving a portable phone, and would entail the delay caused by such a user receiving a phone call and making another phone call.

Moreover, both Sudo and Groenteman are totally devoid of any concept of providing a hand held transceiver, regardless of whether it has telephone features or not, manipulated by an operator to monitor devices in close proximity on a network.

Applicants believe it fair to say that the only reason to combine these two references, springs not from anything in either of the two references, or in any other applied art.

The Office Action then turns to Duarte, which discloses a personal digital assistant, shown in Fig. 8, which has a display 86 with a display screen 51, which displays a curved file hierarchy on the left side of the display screen, and a preview image window 23 on the right side of the display screen (for showing an image of a file located on the curved file hierarchy located on the left side of the screen). Duarte discloses one or more control knobs 80, that can be

rotated. The result of the rotation of a control knob 80 is movement on the left side of the screen from one identifier or pointer along the curved listing hierarchy 19.

Duarte is concerned with selecting files and applications in a database and displaying information in those files and applications, and contains no disclosure of a communication terminal, like Sudo's portable telephone 10, and contains no disclosure of a transceiver controlling networked office machines without any user input or manipulation, like Groenteman's transceiver 36. In other words, there is nothing among these three disclosures that would motivate one of ordinary skill in the art to combine them in any manner whatsoever.

Yet, the Office Action speculatively concludes that it would be obvious to combine Duarte into Sudo in view of Groenteman because Duarte discloses the same type of portable device as Sudo and Groenteman with a different design but yet the same make up including a CPU, display, memory, etc. The Office Action continues by stating that one of ordinary skill in the art would recognize the navigation techniques taught by Duarte are mere software which can be run on a plurality of portable devices such as Sudo in view of Groenteman, referencing col. 8, lines 51-59 and col. 9, lines 4-13.

Applicants respectfully submit that one of ordinary skill in the art would have no reasonable incentive to "combine Duarte into Sudo in view of Groenteman" for the reason discussed above. Moreover, the rejection never actually discloses what specific structural features of Duarte are to be combined into the structure of Sudo, and what the resulting combination will be, structurally. That important detail is left to Applicant's imagination and speculation. Moreover, regardless of how the Office Action envisions the resulting modified

version of Sudo, it cannot possibly result in, or otherwise render obvious, the claimed invention, which positively recites a combination of features including an array of display objects representing individual devices, said array being at least partially displayed on said display, and a marker displayed on said display, said array and said marker being movable relative to one another, wherein (1) a movement of the movable operating element by an operator results in a substantially coincident movement of said array or marker and (2) said movable operating element is positioned so that it appears to an operator to at least partially overlap with the display such that said array or said marker appears to an operator to be part of the operating element, because neither Sudo nor Duarte discloses this combination of features.

Sudo's shortcomings regarding these claimed features are discussed above. Duarte also fails to disclose or suggest this claimed combination of features for reasons discussed, below.

Duarte's rotatable control knob 80, is clearly shown as being wholly enclosed within the right hand flap of data processing device 49, which is wholly separate and apart from screen 51. No matter how one rotates control knob 80, it will always remain within the confines of that flap, and there will be absolutely no overlap with the curved selection arc located on the left hand side of the screen 51, so there is no way that rotatable control knob 80 can be positioned so that it appears to an operator to be part of the operating element shown on the left hand side of display screen 51.

Applicants respectfully submit that the only reason to combine these three disparate references is improper hindsight reconstruction of the claimed invention based solely on Applicants' disclosure. In this regard, Applicants note that the Court of Appeals for the Federal

Circuit has stated that to imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher. ... One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to depreciate the claimed invention. In re Fine, 837 F.2d 1071, 1075 [5 USPQ2d 1596] (Fed.Cir. 1988) (quoting W.L. Gore Associates Inc. v. Garlock, Inc., 721 F.2d 1540, 1553 [220 USPQ 303] (Fed.Cir. 1983)), Accord Grain Processing Corp. v. American Maize Prod. Co., 840 F.2d 902, 907 [5 USPQ2d 1788] (Fed.Cir. 1988) (“Care must be taken to avoid hindsight reconstruction by using the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit”); Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1568, 1574-75 [1 USPQ2d 1593] (Fed.Cir.), cert. denied, 481 U.S. 1052 (1987); Orthopedic Equipment Co. v. United States, 702 F.2d 1005, 1012 [217 USPQ 193] (Fed.Cir. 1983).

For the aforementioned reasons, Applicants respectfully submit that the Office Action fails to make out a *prima facie* case of obviousness of the claimed invention.

Further, with respect to claim 10, Applicants have reviewed Fig. 14 of Sudo and find no disclosure that its scroll knob 4 or jog wheel 36j is made of flexible material.

Further, with respect to claim 15, the only reference directed to an office machine network only discloses that its transceiver 36 can be located internal to, or external of an office machine and in this sense alone discloses a portable transceiver, i.e., can be located in different positions, but in no way does this transceiver present the information to an operator. Instead, it

merely transmits information to a base station.

With respect to claim 18, this claim recites features similar to those recited in claim 1, and includes the following positively recited features, i.e., an array of display objects representing individual devices, said array being at least partially displayed on said display, and a marker displayed on said display, said array and said marker being movable relative to one another, wherein a movement of the mechanically movable operating element by an operator in a given direction results in a substantially coincident movement of said array or marker in the given direction, and said movable operating element is disposed below the display in a partially overlapping position therewith, and the displayed array and the displayed marker are positioned on the display in such a way that one of them moves in unison with the movable operating element so as to appear to an observer of the display as if it is an integral part of the movable operating element.

None of the three applied references discloses or suggests this combination of features. Sudo fails to disclose that its movable operating element (e.g., jog wheel 36j) is disposed below the display in a partially overlapping position therewith, and the displayed array and the displayed marker are positioned on the display in such a way that one of them moves in unison with the movable operating element positioned so that it appears to an observer of the display as if it is an integral part of the movable operating element, as claimed. Rather, there is no apparent overlap whatsoever of Sudo's scroll knob 4 or its jog wheel 36j with Sudo's display, in any way whatsoever, let alone so that either the marker or the displayed array appears to an observer to be an integral part of the movable operating element. To the contrary, the only part of scroll knob 4

or jog wheel 36j that appears visually to an operator is the part of the scroll knob or jog wheel that does not overlap in any way whatsoever with Sudo's display (12 or 35).

Groenteman contains absolutely no details of a display or a user interface. Duarte's rotatable control knob 80 is clearly shown as being wholly enclosed within the right hand flap of data processing device 49, which is wholly separate and apart from screen 51. No matter how one rotates control knob 80, it will always remain within the confines of that flap, and there will be absolutely no overlap with the curved selection arc located on the left hand side of the screen 51, so there is no way that Duarte's displayed array or displayed marker are positioned in such a way that one of them, both of which are shown on the left hand side of display 51, moves in unison with the movable operating element 80 so as to appear to an observer of the display as if it is an integral part of the movable operating element.

Accordingly, no matter how these three references are combined, they cannot possibly result in, or otherwise render obvious, the claimed invention.

Thus, the Office Action fails to present a *prima facie* case of obviousness of the invention recited in claims 1-19.

Reconsideration and withdrawal of this rejection of claims 1-19 are respectfully requested.

New Claim 20

Claim 20 is added. Claim 20 recites a combination of features that is fully supported by applicants' originally filed disclosure, including Fig. 1 and the portions of the specification that describe Fig. 1. In this regard, Applicants point out that it has been held that

drawings alone constitute proper disclosure even if what is shown in the drawings is accidental. See Ex parte Prybil, 156 USPQ 64 (Bd. Pat. App 1967). Moreover, such disclosure is available for all that it teaches one of ordinary skill in the art. See In re Meng and Driessen, 181 USPQ 94 (CCPA 1974) and In re Aslanian, 200 USPQ 500 (CCPA 1979).

Applicants respectfully submit that none of the three applied references disclose or suggest the combination of features positively recited in claim 20.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46,472, at (703) 205-8076, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

Application No.: 10/682,036
Art Unit 2179

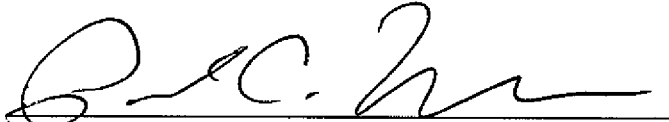
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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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